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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/220,851 03/31/94 MOTTIER

W CL00497RD01

EXAMINER ZIMMERMAN, B

B2M1/0927

ART UNIT	PAPER NUMBER
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JONATHAN P. MEYER
MOTOROLA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
600 NORTH U.S. HWY 45
LIBERTYVILLE, ILLINOIS 60048

2211

DATE MAILED: 09/27/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 7/3/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 19-24, 26-31, 33-38 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-18, 25, 32, 39 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 19-24, 26-31, 33-38 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

EXAMINER'S RESPONSE

Status of Application.

1. In response to the applicant's amendment received on 7/3/95. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 19-24,26-31,33-38 are unpatentable for the reasons set forth in this office action:

INFORMALITIES

2. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated below.

- (a) Title of the Invention.
- (b) Cross-References to Related Applications (if any).
- (c) Statement as to rights to inventions made under Federally-sponsored research and development (if any).
- (d) Background of the invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 C.F.R. §§ 1.97-1.99.
- (e) Summary of the Invention.
- (f) Brief Description of the Drawing.
- (g) Description of the Preferred Embodiment(s).
- (h) Claim(s).
- (i) Abstract of the Disclosure.

Specifically, the application does not contain a "Summary of the Invention."

ART REJECTION

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 19-24,26-31,33-38 are rejected under 35 U.S.C. § 103 as being
unpatentable over Breeden and Yamasaki. Yamasaki shows a radio including a
receiver 2 which receives an information signal. The radio also includes a silent alert
means 10 and an audible alert means 12. The radio also including a processing
means 3,5,6,8. The processing means activates the silent alert for a first time t1, then
activates the audible alert for a second time (t1-t2) wherein t1 is exclusive of t2, and
the second time follows the first time, ie only one alert at a time (see figure 2).

Audible and vibrating alerts are periodic and since there is a limited time for their
activity, the times of activation would inherently equal a specific number of cycles.

Yamasaki teaches the silent alert first and alternatively the audible alert first, see col.

5 lines 40-44. Yamasaki accomplishes efficiency in power utilization in the above

scheme. In an analogous art, Breeden shows a radio RF receiver which includes a
processor 454 and a transmitter and receiver. Breeden teaches the radio receiver can
also function as a transmitter to transmit a second RF signal. This signal is created
by an audio transducer (microphone) 458 or a keypad 466. The second signal is
transmitted via an antenna. Breeden uses a display 464 to display RF call signals, a
speaker to emit RF call signals 458. Breeden suggests the utilization of common

audible, visual and tactile alerts, leaving the details to the routineer. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the alerting function of Yamasaki in a bidirectional voice pager of Breeden to efficiently save battery power. The examiner takes official notice that
5 pagers commonly (necessarily) include a battery for power. The examiner also takes notice that it is common to utilize the same antenna for transmission and reception (this is suggested by Breeden 452).

DOUBLE PATENTING

5. Claims 19,26,33 are provisionally rejected under the judicially created doctrine
10 of non-obviousness-type double patenting as being unpatentable over claims 1,18,19,20 of U.S. application No. 220949 and claims 19,24,29,34 of U.S. application No. 220856.

The non-obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of
15 the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Schneller*, 397 f.2d 350,158 USPQ 210(CCPA 1968). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37
20 C.F.R. § 1.78(d).

A two part test is applied to the claims. 1) is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent. If yes, the second test is 2) is there any reason why applicant was prevented from presenting the same claims for examination in the issued patent (application) if the answer is no a double patenting rejection is appropriate.

Here, the subject matter recited in the pending claim is fully disclosed in the applications referred above and covers the same subject matter covered by claims 1,18,19,20 of U.S. application No. 220949 and claims 19,24,29,34 of U.S. application No. 220856. Further, there was no reason why applicant was prevented from presenting the same claim for examination in the other application. The applicant has not maintained a clear line of demarkation between the above applications. Furthermore, the applicant appears to intend the above applications referring to the same subject matter since all have the same title.

6. Claims 21-25,28-32,35-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,18,19,20 of U.S. application No. 220949 and claims 19,24,29,34 of application No. 220856 in view of Breeden as discussed above.

7. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed

terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

REMARKS

5 **Response to Arguments.**

The following discussion is introduced in direct response to the arguments presented in the instant amendment:

8. The applicant believes that the claimed invention differs from the prior art of record for the following reasons:

10 a. The applicant argues that the vibrating alert in Yamasaki is not generated for a predetermined number of cycles. The applicant submits that during the vibration mode in Yamasaki the vibrating alert is generated continuously.

b. The applicant argues that the present claims only include a receiver while the other applications are directed to an accessory and a transmitter.

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9. Regarding the applicants arguments the examiner points out the following:

a. As is well known in the art, a vibrating alert is generated by the oscillating motion of a mass. The oscillating motion of a mass is periodic in nature, in that the motion occurs at regular intervals. These intervals, are by definition the period of the oscillation, a measurement of an amount of time. Since the vibration lasts a specific

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length of time, the duration of the vibration can be expressed a length of time or can expressed by a number or periods.

b. The applicant has not addressed the obviousness type double patenting rejection; it is maintained. The applicant's argument contesting the non-obviousness-
5 type double patenting rejection is not persuasive. The applicant is claiming here, the same elements and operation of those elements as in the claims of the other applications, the issuance of these applications at different times would unfairly extend the coverage of the subject matter beyond the statutory period. As further evidence that the references claim the same subject matter, it is noted that the arguments
10 presented by the applicant in this application are equivalent to those presented in serial number 08/220856.

Applicant's amendment necessitated the new grounds of rejection. Accordingly,
THIS ACTION IS MADE FINAL. See M.P.E.P. § 706.07(a). Applicant is reminded of
15 the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT
20 MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE
25 STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS

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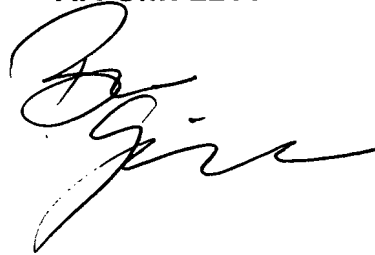
FROM THE DATE OF THIS FINAL ACTION.

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Zimmerman whose telephone number is (703) 305-4796.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4900.

**Brian Zimmerman
Patent Examiner
Art Unit 2211**



baz
703-305-4796